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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,952	01/24/2001	Kazunobu Katoh	3709-0101P	2787

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EXAMINER

CHEA, THORL

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 11/04/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/767,952

Examiner

Thorl Chea

Applicant(s)

KATOH, KAZUNOBU

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-15, 17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1752

DETAILED ACTION

1. The finality of the rejection of the last Office action is withdrawn in view of the newly found references EP 0803764.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1 –11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The language “in an amount that is 10 wt % or less of the coated amount of photosensitive silver halide in the photosensitive layer “ is unclear with respect to the antecedent basis for “the photosensitive silver halide” is the silver-supplying layer is considered as photosensitive layer itself since its contains photosensitive silver halide of 10 wt % or less.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1752

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-3, 12-13, 15, 17-18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP0803764 (EP'764). See photosensitive layer which contains silver halide on page 3, lines 40-46; the non-photosensitive layer having organic silver salt and reducing agent therefore on page 5, lines 39-50 and page 25, lines 10-15; the formation of photosensitive and non photosensitive layer on page 25, lines 15-20; the coating of non-photosensitive layer on the same surface of the support as said photosensitive layer on page 44, claim 21; on page 25, lines 5-8, it is disclosed that the photosensitive layer contains silver halide and the binder, the other components including a non-photosensitive silver salt, reducing agent therefore, toner hydrazine derivative, dye, filler surfactant and crosslinking agent may also added if necessary; the two or more photosensitive layer is disclosed on page 3 under "photosensitive layer". The photothermographic material of the EP'764 contains same photographic additives used in the present invention. Note for instance the enhancing agent such as hydrazine compound on page 21, lines 49-55; antifoggant such as halogenated on pages 21, lines 3-6.

The EP'764 discloses the photothermographic material wherein the photosensitive silver halide is in a separate layer from that containing silver salt of an organic acid or in the same layer with that containing silver salt of an organic acid. The EP'764 discloses a photothermographic material two layers structure similar to that of the claimed invention which is anticipated the claimed material. Alternatively, it would have been

Art Unit: 1752

obvious to use the silver halide and silver salt of an organic acid in same layer such as suggested therein providing a highly useful material.

2. Claims 4-11, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0803764 (EP'764) as applied to claims 1-3, 12-13, 15, 17-18 above, and further in view of Murray ('324), Murray et al ('515) and Toya et al (Toya).

The halogen precursor has been known in Toya as antifoggant for photothermographic material and the electron transfer such as hydrazine and alkene derivative and isooxazole derivative have been known as contrast enhancer and taught in Murray, and it would have been obvious to use thereof in the material of EP'764 to improve the image contrast thereof to provide the invention as claimed.

Response to Arguments

3. Applicant's arguments filed October 16, 2002 have been fully considered but they are not persuasive because of the rejection set forth above. The "(E)vidence of secondary considerations, such as unexpected results or commercial success, is irrelevant to 35 U.S.C 102 rejections and thus cannot overcome a rejection so based. In re Wiggins, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973). Supposedly, the claimed invention is not anticipated by EP'764 and the claimed invention would have been found prima facie obvious over EP'764, the results shown in the specification would have been expected from the teaching of EP'764. The material taught in EP'764 produce image with good color tone with less fog even after storage in humid atmosphere.

Art Unit: 1752


C nclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (703)308-3498. The examiner can normally be reached on M-F (9:30 - 6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C Baxter can be reached on (703)308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9301 for regular communications and (703)872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

tchea 
October 28, 2002


Thorl Chea
Primary Examiner
Art Unit 1752